

REMARKS

A. INTRODUCTION

Claims 1, 41, 42, 49, 56-62 and 65-80 are pending and rejected.

Claims 1, 41, 42, 49, 71 and 72 were withdrawn and not examined.
Applicants respectfully traverse the restriction

Upon entry of this Amendment:

- Claims 56-62, 65-70 and 73-81 will be pending
- Claims 75-80 will be amended
- Claim 81 will be added
- Claims 1, 41, 42, 49, 71 and 72 will be cancelled without prejudice
- Claims 56, 61, 62, and 75-80 will be the only independent claims

B. REQUEST FOR CONTINUED EXAMINATION

This paper is being filed in response to an Office Action mailed June 13, 2008. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of these remarks.

C. ELECTION/RESTRICTION

In response to the Examiner's withdrawal from consideration of Claims 1, 41, 42, 49, 71 and 72, Applicants have cancelled those claims.

D. SECTION 103(A) REJECTIONS

Claims 56-61, 65, 73-78 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Katz, and further in view of Reilly (Brian Reilly "Upselling strategies hit the net", Net Marketing, December 1996), Logan, Spoor, Chelliah, Ellis and Donlon.

Claims 62, 79 and 80 stand rejected as being unpatentable over Katz in view of Logan, and Donlon or Discount Store News.

Claim 66 stands rejected as being unpatentable over Katz, Donlon or Discount Store News, Logan and Spoor in further view of Tedesco.

Claims 67 and 68 stand rejected as being unpatentable over Katz, Reilly, Chelliah, Sloane, Donlon, Discount Store News, Spoor, Ellis, Logan and Fleming.

Claims 69 and 70 stand rejected as being unpatentable over Katz, Reilly, Chelliah, Sloane, Donlon, Discount Store News, Spoor, Ellis, Logan and in further view of Colman (Broadcasting & Cable).

Applicants respectfully traverse the Examiner's Section 103(a) rejection.

1. Claims 56-61, 65-70 and 73-78 (and new Claim 81)

Claims 56, 61, and 75-78 are independent claims. Claims 57-60, 73 and 74 depend from Claim 56. New Claim 81 depends from Claim 56. Claims 65-70 depend from Claim 61.

No combination of the cited references teaches or suggests a web page allowing for a choice between paying the associated total price or receiving an offer for a reduction in the total price, as described in the Specification (e.g., FIGs. 10 and 11 and accompanying text). Applicants submit that no combination of the cited references provides for the recited combination of features, nor do the cited references evidence an apparent reason to provide for that specific combination.

The Office Action states that Spoor and Ellis disclose "providers switching" and that this disclosure would have suggested permitting advertisers such as service providers to implement their advertising method...such as taking advantage of Katz's upsell profiling/targeting methods." [Office Action, page 5]. Applicants respectfully disagree. Neither Spoor nor Ellis suggest the desirability of "taking advantage" of another system's "upsell profiling/targeting methods" to provide a subsidy by a second vendor to discount a purchase from a first vendor. Applicants request what portion of the Spoor or Ellis references are being relied upon as substantial evidence supporting the Examiner's findings.

The Examiner also concedes that Katz, Reilly, Logan, and Chelliah are devoid of a suggestion of a subsidy by a second vendor to discount a purchase from a first vendor. The Sloane, Donlon and Discount Store News references are similarly devoid of a hint of the suggested motivation. Applicants request what portions of these references are being relied upon as substantial evidence supporting the Examiner's findings. Nothing in either Sloane, Discount Store News or Donlon suggests a commitment to a service agreement offered by a second vendor. In Discount Store News, for example, the "cross-selling" is with respect only to prepackaged combinations of store-shelf products to be purchased only from one vendor. In Donlon, there is no requirement of a service agreement, nor is there any hint of applying the "coupon" to the cable bill with which it is provided. Sloane describes promoting discounts on competitive or complementary products, but does not suggest an offer for a subsidy from a second vendor applicable to purchase of a product of a second vendor, as suggested in the Office Action.

The Office Action also states it would have been obvious "because the technique for improving a particular class of marketing system was part of the ordinary capabilities of a person of ordinary skill in the marketing art, in view of

the teaching of the technique for improvement in other situations such as the implementation of an upselling system based on profiling and targeted advertising to the service provider field.” Applicants do not agree with this statement. The “technique” (as generally claimed, offering by a second merchant a subsidy on a purchase from a first merchant in exchange for a service agreement that is not required for any item in the purchase) was not known, and therefore it would not have been known or deemed desirable to improve the Katz system in the manner suggested by the Examiner to provide for such a feature. That it was known to target advertising, even by service providers, does not suggest effectively allowing a second merchant to intervene in a purchase between a customer and a first merchant, much less unnecessarily increasing the complexity of the Katz system to provide for such a feature.

Regardless, even if such a motivation were established by substantial evidence (which it has not), no combination of the cited references teaches or suggests a web page allowing for a choice, at the time the customer has already indicated a readiness to purchase an item, between paying the associated total price or receiving an offer from a second merchant for a reduction in the total price the customer would owe to a first merchant.

For at least these reasons, Applicants respectfully request the Examiner’s reconsideration and withdrawal of the Section 103(a) rejections of Claims 56-61, 65-70 and 73-78.

2. Claims 62, 79, and 80

Independent Claim 62 has not been amended. Claim 62 recites *after activating the button, receiving a signal that the customer has clicked the button; and providing, in response to the received signal, an offer for a subsidy from the second merchant, the step of providing the offer being performed before the purchase is consummated but only after receiving the signal that the customer has clicked the button, whereby the offer is not provided unless and until the signal is received.* Claims 79 and 80 have been amended in order to incorporate explicitly what was incorporated previously by reference; the scope of Claims 79 and 80 has not changed.

Even after notifying the Examiner of the specific features of Claims 62, 79 and 80 that were not addressed in the previous Office Action, the present Office Action still does not address any of the above explicit limitations related to activation of a button and functions performed only after receiving a signal is received that the customer has clicked the button. For at least this reason, no prima facie case of obviousness has been provided for independent Claims 62, 79, and 80. Further, Applicants submit that no combination of the cited references

provides for the recited combination of features, nor do the cited references evidence an apparent reason to provide for that specific combination.

Accordingly, Applicants request reconsideration and allowance of independent Claims 62, 79 and 80.

E. ADDITIONAL COMMENTS

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

F. NEWLY-ADDED CLAIM 81 IS PATENTABLE OVER THE CITED REFERENCES

Newly-added Claim 81 is patentable over the cited references for at least the reasons presented herein.

As described above, the cited references alone or in combination fail to teach or suggest all of the features of independent Claim 56, from which new Claim 81 depends. Additionally, the cited references do not teach or suggest the additional limitation of Claim 81:

in which providing to the customer an offer for the subsidy from the second merchant comprises:

transmitting a web page to the customer, the web page including:

the offer for the subsidy from the second merchant to have the purchase provided to the customer free of charge in exchange for the customer agreeing to sign up for a first service with the second merchant, in which the first service is not required for use of any item of the purchase, and

an offer for a subsidy from a third merchant to have the item purchase provided to the customer free of charge in exchange for the customer agreeing to sign up for a second service with the third merchant, in which the second service is not required for use of any item of the purchase.

For at least the reasons stated herein, we respectfully submit that new Claim 81 contains allowable subject matter.

G. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a three-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$1110.00

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H. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.

Respectfully submitted,

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Date

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